



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,698	03/04/2004	James J. Mehail	62219-MAIND	5122
20736	7590	04/04/2005	EXAMINER	
MANELLI DENISON & SELTER 2000 M STREET NW SUITE 700 WASHINGTON, DC 20036-3307			KOCZO JR, MICHAEL	
			ART UNIT	PAPER NUMBER
			3746	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,698

Applicant(s)

MEHAIL, JAMES J.

Examiner

Michael Koczo, Jr.

Art Unit

3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03-04-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claims 1, 3 and 5 objected to because of the following informalities:

In claim 1, line 3 from the bottom, "ad" should read --and--.

In claim 3, there is no antecedent basis for "said compressed gaseous fuel--". This claim is furthermore redundant because claim 1 already recites natural gas as the fuel.

In claim 5, line 2, --line-- should be inserted following "main".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leidel in view of Viteri and Van Arsdell. Leidel discloses an external combustion engine wherein a compressor 18 compresses air, which air is then fed to a high pressure air vessel 22 and then to a combustor 34. The combustion products are fed to a reciprocating piston engine. The engine drives the compressor. However, Leidel does not disclose using natural gas as the fuel, and driving an electrical generator by the engine. Viteri discloses an external combustion engine which uses natural gas as the fuel. Natural gas when combusted produces fewer harmful

Art Unit: 3746

emissions as compared to other hydrocarbon fuels such as gasoline and diesel fuel. Van Arsdel discloses an external combustion engine wherein the gas motor 157 drives a generator 158 (col. 5, lines 57 and 58). This of course charges the battery and provides power for driving accessories such as the fuel pump. In view of these teachings, it would have been obvious to utilize natural gas as the fuel in Leidel, and to utilize the engine of Leidel to drive a generator. The line which feeds high pressure natural gas to the combustion chamber is readable as a "high pressure main line".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,334,300 in view of Van Arsdel. Claim 12 of U.S. Patent No. 6,334,300 recites the combination substantially as claimed. However, this claim does not include generating electricity from the combusted gas. Van Arsdel discloses an external combustion engine wherein the gas motor 157 drives a generator 158 (col. 5, lines 57 and 58). This of course charges the battery and provides power

Art Unit: 3746

for driving accessories such as the fuel pump. In view of this teaching, it would have been obvious to utilize the expansible chamber motor of claim 12 of U.S. Patent No. 6,334,300 to drive a generator.

Claims 6, 7 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,334,300 in view of Van Arsdel and Viteri. Claim 5 of U.S. Patent No. 6,334,300 recites the combination substantially as claimed. However, this claim does not include generating electricity from the combusted gas. Van Arsdel discloses an external combustion engine wherein the gas motor 157 drives a generator 158 (col. 5, lines 57 and 58). This of course charges the battery and provides power for driving accessories such as the fuel pump. In view of this teaching, it would have been obvious to utilize the expansible chamber motor of claim 12 of U.S. Patent No. 6,334,300 to drive a generator. Claim 5 of U.S. Patent No. 6,334,300 also does not recite using natural gas as the fuel. Viteri discloses an external combustion engine which uses natural gas as the fuel. Natural gas when combusted produces fewer harmful emissions as compared to other hydrocarbon fuels such as gasoline and diesel fuel. In view of these teachings, it would have been obvious to utilize the expansible chamber motor of claim 5 of U.S. Patent No. 6,334,300 to drive a generator and to use natural gas as the fuel.

Claims 1, 2, 3 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 42 of U.S. Patent No. 6,490,854 in view of Viteri. Claim 42 of U.S. Patent No. 6,490,854 recites the combination substantially as claimed. However, this claim does not include using natural gas as the fuel. Viteri discloses an external combustion engine which uses natural gas as the fuel. Natural gas when combusted produces

Art Unit: 3746

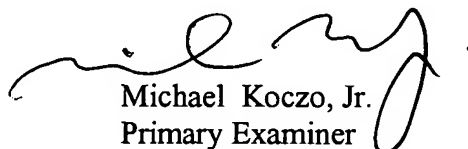
fewer harmful emissions as compared to other hydrocarbon fuels such as gasoline and diesel fuel. In view of these teachings, it would have been obvious to use natural gas as the fuel in the engine as recited in claim 42 of U.S. Patent No. 6,490,854.

Any inquiry relating to patent applications in general should be directed to the Patent Assistance Center at 1-800-786-9199.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kocz, Jr. whose telephone number is 571-272-4830. The examiner can normally be reached on M-Th; 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached at 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Kocz, Jr.
Primary Examiner
Art Unit 3746